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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,641	03/07/2001	Kent E. Seamons	GB920000044US3	3334
7590		10/20/2005		
Jeanine S. Ray-Yarletts IBM Corporation T81/503 P.O. Box 12195 Research Triangle Park, NC 27709			EXAMINER LIVERSEDGE, JENNIFER L	
			ART UNIT 3628	PAPER NUMBER
DATE MAILED: 10/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/800,641	SEAMONS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer Liversedge	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/800,641 (March 7, 2001) filed on March 17, 2005.

The amendment contains amended claims 1, 7 and 8.

The amendment contains amended abstract.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sandberg-Diment (US PAT 5,826,245).

Re claim 1, 7 and 8: Sandberg-Diment teaches a system and method comprising: A automated trust negotiations between first and second parties connected over a network (see Fig 2), comprising the steps of: providing each party with a set of credentials, wherein a credential (i.e. customer name, portion of a credit card number, see column 2, lines 31-35 and column 3, lines 16-18) provides an authorization of a

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property of its respective party, classifying one or more credentials (classifying credentials is interpreted as customers name, address, tags and purchase order, see column 3 lines 17-20) in the set of credentials for said first party as sensitive (i.e. confidential, see column 1, lines 60-65), such that they can only be disclosed to another party subject to certain predetermined criteria (see column 1, lines 36-42), establishing negotiations over the network between said first and second parties in order to complete a desired transaction, wherein said transaction is only authorized to proceed if at least one of the parties receives certain predetermined credentials (i.e. a randomly generated tag, see column 1, lines 62-67) from the other party; and transmitting at least one of the one or more sensitive credentials from the first party to the second party as part of said negotiations (portions of a credit card number and/or a tag generated by a computer see column 2, lines 49-55), subject to the first party previously receiving from the second party one or more credentials that satisfy said certain predetermined criteria (i.e. sending the credit card information from the initiating party to the verifying party, see lines 40-48); wherein said first and second parties are a server (i.e. verifying party) and a client (i.e. initiating party) respectively, wherein said server is to perform the desired transaction in response to a request from the client (i.e. the initiating party, see column 1, lines 37-40); wherein the server specifies a set of credentials (i.e. the credit card number, see column 2, lines 32-33) that it must receive from a client in order to set up or perform the transaction (see column 2, lines 40-45); wherein both the client and the server have one or more credentials in their respective sets of credentials which are classified as sensitive, such that they can only be disclosed to another party subject to

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certain predetermined criteria; wherein the negotiations over the network between the client and the server in order to complete a desired transaction include transmitting at least one of the one or more sensitive credentials from the client to the server as part of said negotiations subject to the client previously receiving from the server one or more credentials that satisfy said certain predetermined criteria for the client (see column 3, lines 8-22); wherein at least one party adopts an eager strategy, according to which all sensitive credentials are transmitted to the other party subject only to receipt of certain predetermined credentials from the other party (see column 2, lines 49-59), irrespective of whether or not transmission of such sensitive credentials is necessary in order to complete said transaction; and wherein at least one party adopts a parsimonious strategy, according to which only selected sensitive credentials are transmitted to the other party from the set of sensitive credentials that could be transmitted after receipt of certain predetermined credentials from the other party, said selection being performed on the basis of transmitting only those sensitive credentials that are specifically necessary in order to complete said transaction (see column 3, lines 43-54).

A Computer program would have been inherent to perform the method shown by Sandberg-Diment as stated supra. And per modified claim 7, a computer program product stored on a computer readable storage medium to be run on a computer system to carry out the method shown by Sandberg-Diment would have been inherent.

Re Claim 2: The method, wherein said first and second parties are a client and a server respectively, wherein said server is to perform the desired transaction in response to a request from the client (see Fig 1 and 2).

Re Claim 3: The method, wherein in order to set up or perform the transaction, the client is required to supply at least one of the one or more sensitive credentials to the server (see column 1, lines 37-42).

Re Claim 4: The method, wherein said parsimonious strategy involves the exchange of credential requests to establish a point of confidence prior to transmission of credentials themselves (see column 2, lines 1-20).

Re Claim 5: The method, wherein at least one party initially adopts an eager strategy, according to which all sensitive credentials are transmitted to the other party subject only to receipt of certain predetermined credentials from the other party (see column 2, lines 1-3), irrespective of whether or not transmission of such sensitive credentials is necessary in order to complete said transaction, and then at a later stage of said negotiations subsequently adopts a parsimonious strategy, according to which only selected sensitive credentials (i.e. tag) are transmitted to the other party from the set of sensitive credentials that could be transmitted after receipt of certain predetermined credentials from the other party, said selection being performed on the

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basis of transmitting only those sensitive credentials that are specifically necessary in order to complete said transaction (see column 3, lines 10-15 and 23-27).

Re Claim 6: The method, wherein said server defines a service governing policy that specifies certain roles, such that said client can only set up or perform the transaction if it has sufficient credentials to allow it to assume one of said certain roles (i.e. the initiating party has to have a credit card number in order to perform the transaction, see column 1, lines 7-12).

### ***Response to Arguments***

Applicant's arguments filed regarding 35 USC § 102 have been fully considered but they are not persuasive. The art cited in Sandberg-Diment teaches the claims as filed by the Applicant. In the Applicant's remarks, reference is made to a "credential access policy" (page 10, line 29) as a distinguishing point between the Applicant's claims and the art disclosed by Sandberg-Diment. However, the examiner notes that the claims as cited in the current application are taught by Sandberg-Diment in terms of providing a network to exchange sensitive information in whole or in part. While the Applicant discusses "trust negotiation" (page 10, line 37), the claim language as presented does not disclose art which is distinct from the art as disclosed by Sandberg-Diment.

Regarding the use of an "eager" strategy and a "parsimonious" strategy as being used in the verification process, the examiner notes that Sandberg-Diment discloses

both types of transactions. The “eager” strategy involving providing all information, whether required or not, at one time is disclosed as cited in the Office Action and further as background in column 1, lines 5 – 30. The traditional means for receiving verification is to send all information upon initiating a transaction, as disclosed in the Background section of the Sandberg-Diment patent. From there, Sandberg-Diment discloses a system using the “parsimonious” strategy such that information is sent for verification to a verifying body in segments, such that all of the information is not being disclosed at one time. The initial Office Action pointed to column 2, lines 49 – 59 as illustrating each method. In the first portion, the consumer is entering the whole of the information such as credit card number, expiration date, and the purchase order. If this information were to be sent out in that form, as disclosed in the Background, the method would be of the “eager” nature. However, the remainder of that passage discloses that the information is then split up and grouped for delayed transmittal to a verifying body.

The Applicant’s claim 1 claim language and Applicant’s remarks on page 11 in the last paragraph, the claim language as provided by the Applicant does not indicate that all of the sensitive information must be shared amongst two parties. The language calls for “at least one” of the sensitive pieces to be shared. Sandberg-Diment clearly discloses wherein at least one piece of sensitive information is being shared as cited in the previous and current Office Application and referenced in the Applicant’s remarks on page 11.

Regarding the teaching of a “parsimonious” strategy, Sandberg-Diment discloses a system using the “parsimonious” strategy such that information is sent for verification

to a verifying body in segments, such that all of the information is not being disclosed at one time. As per the Applicant's response to column 3, lines 34 through 54, the information contained therein discloses sending information in pieces, separating sensitive information such that it is not communicated in one transmittal. That, in conjunction with the other discussion as presented in this Response to Arguments, points to the disclosure of a "parsimonious" strategy being disclosed by Sandberg-Diment.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

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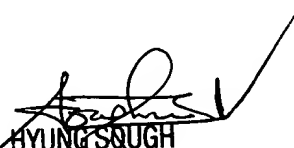
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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TECHNOLOGY CENTER 3600